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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,913	06/14/2001	Mitsuru Maeda	35.C15455	5554

5514 7590 09/02/2005

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30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/879,913

Applicant(s)

MAEDA, MITSURU

Examiner

Matthew Heneghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-12,14-18,20-22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12,14-18,20-22 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                       |                                                                                        |
|-----------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____                                                |

### **DETAILED ACTION**

1. In response to the previous office action, claims 1-3, 5, 8, 12, 14-16, 20, 22, and 24-31 have been amended and claims 7, 13, 19, and 23 have been cancelled. Claims 1-6, 8-12, 14-18, 20-22, and 24-31 have been examined.

#### ***Drawings***

2. The drawings were received on 21 June 2005. These drawings are acceptable.

#### ***Claim Objections***

3. In view of Applicant's amendments, all previous claim objections are withdrawn.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 4-6, 8-12, 14, 17, 18, 20, 22, and 24-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Each claim teaches solely to the abstract manipulation of data.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 8-12, 14-18, 20-22, and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Publication No. 99/48296 to Shamoon et al. in view of U.S. Patent Publication No. 2001/0016851 to Gramsamer et al.

As per claims 1-3, 8-12, 14-16, 20, 22, and 24-31 Shamoon discloses a streaming media system that includes a control block containing data from a Control Stream that is watermarked (i.e. combined into raw data) into audio and visual streams (see p. 7, lines 23-26). The Control is an IPMP (Intellectual Property Management and Protection) component (see p. 4, line 27 and p.5, lines 6-9 and p.21, lines 23-27) of an MPEG-4 stream (see column 4, lines 21-22) that includes rules governing use of intellectual property (see p.12, line 11 to p. 19, line 5).

Shamoon does not disclose the use of a data field in the intellectual property information that is related to patent details.

Gramsamer discloses an archiving and retrieval system wherein a Unique Identifier (UID) is watermarked into a document that denotes intellectual property information (see paragraph 12), with access policies are based upon the UID (see

paragraphs 21, 22, and 25), and suggests the creation of such data based upon a patent number and country (see paragraph 7), and suggests that this provides a means for retrieving millions of patents of various countries.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Shamoon by including a UID indicative of patent information by country in the intellectual property information, as disclosed by Gramsamer, as this provides a means for retrieving millions of patents of various countries.

As per claim 4, 17, and 18, the audio and visual streams may be encrypted prior to combining with the control stream (see Shamoon, p.4, lines 28 and 32).

As per claim 5, cryptographic keys for encrypting the data streams are initially contained in the Control Stream before being utilized in the Control Block during decryption (see Shamoon, p.5, lines 8-9 and p. 9, line 30 to p. 10, line 12). Since symmetric keys, such as DES (see p.26, lines 17-19) may be used, the encryption and decryption keys are the same.

As per claim 6, the encoding means is also capable of using public-key signatures (see Shamoon, p. 18, lines 10-13).

As per claim 21, received video is displayed (see Shamoon, p. 6, 19-24).

### ***Response to Arguments***

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6. Regarding the rejections under 35 U.S.C. 101, Applicant's arguments filed 21 June 2005 have been fully considered but they are not persuasive. The claims as presented do not necessarily teach to a machine, and constitute or employ functional descriptive material that is not tangibly embodied. The claims are therefore still non-statutory.

7. Regarding the rejections under 35 U.S.C. 103, Applicant's arguments filed 21 June 2005 have been fully considered but they are not persuasive. Shamoan discloses a use of IPMP for any type of intellectual property information (copyrights, patents, trademarks, etc.), while Gransamer specifically teaches to the use of such information regarding patents. In combination, they teach to the use of patent information in IPMP fields as claimed.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

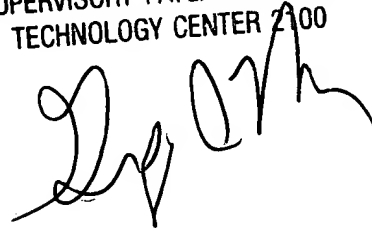
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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH *MEH*

August 31, 2005

GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

A handwritten signature in black ink, appearing to read 'G. Morse', is written over the printed name and title of Gregory Morse.